

REJECTIONS:

The earlier objection to the Title was dropped, apparently in view of the new title submitted in the prior response to the first Office Action.

The earlier rejection of Claims 1 - 8 under 35 U.S.C. § 112, second paragraph, was dropped, apparently in view of the amendments therein submitted in the prior response to the first Office Action.

The earlier rejection of Claims 1 - 8 under 35 U.S.C. § 102(e) as anticipated by the reference PEPE ET AL (US 5,742,905) was dropped, apparently in view of the arguments submitted in the prior response to the first Office Action and the following rejections were newly applied.

Claims 1 - 6 and 9 were newly rejected under 35 U.S.C. § 103(a) as obvious and unpatentable over the newly-cited reference EMERY ET AL (US 5,353,331) on the grounds that EMERY discloses most of the claimed features and those lacking would be obvious to implement as claimed.

Claims 7 and 8 were newly rejected under 35 U.S.C. § 103(a) as obvious and unpatentable over the newly-cited reference EMERY ET AL (US 5,353,331) in view of the newly-cited reference KITZIK (US 5,983,073) on the grounds that EMERY discloses all of the claimed features except messages that are generated on the basis of notification of calendar events, for which feature KITZIK was offered.

REPLY:

The title has been amended to better indicate the subject matter of the invention and reflect the language in the claims.

The claims have been extensively amended to remove the informal language therefrom and are now believed to be in proper statutory form.

Regarding the prior art rejections, Applicant would like first to emphasize that the invention involves a method and system in which messages, e.g., Short Message Service (SMS) messages, addressed to a recipient's primary mobile station that receives both voice calls

and messages, can be directed to any one of the secondary mobile stations of the recipient. The rejection of the cited claims on EMERY alone contends that EMERY discloses a method for the transmission of messages using a message service to the mobile station of a recipient. However, it is important to note that the feature of EMERY that the rejection addresses actually concentrates on mobility control and the transferring or controlling of a voice call. It does not relate in any way to text or data messages or SMS technology, toward which Applicant's invention is directed. No reference can be found in EMERY to SMS, text or data messages, a short message service center (SM-SC) or paging, that is, to technology in which Applicant's invention is applicable and implementable.

Those of skill in the art would not look to EMERY's teaching with regard to Applicant's invention as they would understand that, since EMERY's teaching is directed to and concentrates on mobility control performed in the core of a communication network, it could be expected to offer nothing of pertinence in dealing with message technology. In contrast to EMERY's communication network, a short message service center (SM-SC), such as to which Applicant's invention relates, is generally an optional network unit outside the communication network, and therefore constitutes, in a manner, a separate area in telecommunication. Nevertheless, even in short message service, an access or gateway must be established between the telephone network and the SM-SC by the service provider (telephone operator). Therefore, throughout EMERY, the term "messaging" relates to out-of-band messaging, that is, call signalling, which concerns signalling during a call. Accordingly, the teachings of EMERY are concentrated on call processing, so that EMERY does not cover text or data messages, such as SMS messages, received by the user to his or her mobile station from another mobile station or a computer, as covered in Applicant's invention. As compared to the invention, all messaging in EMERY is performed by a network element (more particularly the central office switching system and mobility control), but never by the user as in Applicant's invention. The only operation performed by the user in EMERY is call transfer, but as noted in EMERY, this is known as such (DTMF, Col. 30, lines 17-53). Also here EMERY consistently discusses the transfer of calls, i.e., voice, never the transfer of SMS or data or text messages or calendar data, to which Applicant's

invention is directed.

An important feature of Applicant's invention is that it enables the possibility of directing text messages to a secondary mobile phone even if voice calls are directed to the primary mobile phone. This is specified in Claim 1, where it is defined that "messages ... can be directed to any of the secondary mobile stations of the recipient, irrespective of calls". This function provides the possibility that the primary telephone can be being used, e.g., by other family members for normal use, and the user can still direct important messages to a secondary mobile station carried with him. Further, the user can, irrespective of the message transfer function, call the primary mobile station being carried by another (family) member (see Page 5, line 32 to Page 6, line 6). EMERY, whose teachings only refer to calls, and more specifically, to directing certain voice calls to other terminal points, such as a voice mailbox (e.g., Column 8, lines 62 and 63) or a terminal point such as might be assigned to a secretary (Column 9, lines 4 and 5), does not offer these types of solutions at all. Even the initial situation in EMERY is significantly different from that of Applicant's invention in which the user has several personal mobile stations having different properties, e.g., related to functions provided, size or weight. With Applicant's invention the user does not always have to carry his or her primary mobile station, which may have a considerably larger size, e.g., because of such features as Internet, facsimile, or advanced calendar solutions that may require a larger display. The recipient may in certain situations wish to carry his or her secondary, e.g., a very small size mobile station, and can still utilize the aforementioned advantages (Page 1, lines 30-38). The teachings of EMERY do not bring about solutions for these kinds of situations, but rather, they merely offer the recipient the possibility of directing his or her calls elsewhere, e.g., to a voice mail or secretary. It is therefore submitted that EMERY's teaching is inapposite and Applicant's claims which define his invention are patentably distinguishable over it.

Regarding the rejection of Claims 7 and 8 on EMERY in view of DITZIK, it should first be understood that the signalling channels as set forth in EMERY cannot be used for data transfer, only for maintaining voice calls and signalling relating to such calls.

Further, in view of this and the other factors explained above, it is not seen how the mere combination of EMERY and DITZIK would produce a result that could eliminate or solve the problem of how to differentiate calls and SMS messages and direct them to different mobile stations, particularly in the manner as taught by Applicant's invention (e.g., Page 5, lines 1-9).


Based on the significant differences delineated above between Applicant's invention, as particularly defined in the claims, and the teaching of EMERY, taken alone or with that of KITZIK, it is submitted that the cited art fails to render all of the Claims 1 - 9 unpatentable under 35 U.S.C. §103(a) so that their rejection on those grounds should be withdrawn.


In summary, then, the claims having earlier been appropriately amended to put them in proper statutory form and informalities in the Title and specification having been corrected by earlier amendments, it is believed that the application is now in complete conformance with the requirements of the statutes and the claims are patentably distinguishable over the prior art, so that withdrawal of the final rejections, allowance of all of the claims, issuance of a Notice of Allowance and passage to issue of this application is earnestly solicited and respectfully requested.

Corrected formal drawings to replace the informal drawings filed with the application will be submitted upon allowance.

No fee is believed to be required for the entry of this response, but should one be necessary, it is authorized and requested that it be deducted from Deposit Account No. 16-1350, and the response be timely entered.

Respectfully submitted,


Thomas P. Dowd, Reg. No. 24,586


Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06430
Customer No.: 2512

Tel. (203) 259-1800
Fax. (203) 255-5170

CERTIFICATE OF MAILING

I hereby certify that the attached Amendment is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, DC 20231.

Clair L. Mian
Name of Person Making Deposit

2/8/01
Date